

REMARKS

Review and reconsideration of the non-final Office Action mailed March 12, 2008 (the "Office Action") is respectfully requested in view of the above amendments and the following remarks. At the time of the Office Action, claims 1 and 3-6 were pending, with claim 5 being withdrawn. The Office Action rejected all of the claims under 35 U.S.C. §102(b), 35 U.S.C. §103(a), or both. The rejections and response thereto are set forth fully below.

Claim Rejections – 35 U.S.C. § 102 and 35 U.S.C. § 103

In the Office Action, claims 1, 3 and 4 were rejected under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over the translation of PCT Patent Application Publication WO99/20230 filed by Hurschmann *et al.* (hereinafter "Hurschmann"). In the Office Action, claim 6 is rejected under 35 U.S.C. § 103(a) as obvious over Hurschmann in view of U.S. Patent No. 5,800,825 issued to McMullen (hereinafter "McMullen"). In particular, the Office Action references the composition of Hurschmann Formulation R2, *see* Hurschmann, pages 10-11. This rejection is addressed in detail below.

Prior to reviewing the cited reference, Applicants wish to review the pending claims. Claim 1 is drawn to:

1. (previously presented) A moisture-proof mascara composition, characterized by a stable colloidal complex comprising
 - 0.1 to 10 % by weight of a water-soluble polymer selected from among polyvinylpyrrolidone, vinyl acetate/vinyl pyrrolidone copolymers and mixtures thereof,
 - 0.5 to 10 % by weight of stearic acid and
 - 1 to 40 % by weight of a wax or wax mixture,and manufactured by adding the water-soluble polymer or copolymer into the oil phase consisting of the melted wax or wax mixture, stearic acid and optionally an emulsifier, until a stable colloidal complex is formed, and emulsifying the said complex in homogeneous form with an aqueous phase.

It is important to note that the claims are drawn to an oil phase that consists of the melted wax or wax mixture, stearic acid and optionally an emulsifier. *The water-soluble polymer or copolymer is mixed into the melted oil phase until a stable colloidal complex is formed.* After forming the stable water-soluble (co)polymer/oil phase colloidal complex, the stable water-soluble (co)polymer/oil phase colloidal complex is emulsified with an aqueous phase.

The process of mixing the water-soluble polymer or copolymer into the oil phase, formulated with specific components in specific amounts, results in an end product that provides significantly improved moisture-resistance when compared to conventional mascara. As noted in the specification, polyvinyl pyrrolidone is hygroscopic and generally results in smearing of mascara, *see* Specification, paragraph [0003]. However, Applicants have discovered that mixing the wax phase with the PVP containing water-soluble polymer before introducing an aqueous phase produces a mascara with substantially improved moisture resistance, *see* Specification, paragraphs [0028]-[0031]. This demonstrates that the subject matter of claim 1 is physically distinct from compositions made by the methods disclosed in Hurschmann, *see* Specification, paragraph [0033].

Applicants now turn to the Hurschmann reference. The Office Action asserts that Hurschmann discloses a hair mascara composition comprising 8 % stearic acid, 0.5 % Luviskol VA 64 (vinylacetyl-vinylpyrrolidone copolymer), and 0.5-1.0 % carnuba wax. The Office Action goes on to assert that PVP is taught on page 4, and that active agents (*e.g.* pigments, perfumes) and emulsifiers (*e.g.* cetylstearyl alcohol) are also included in the composition.

Applicants respectfully submit that neither Hurschmann nor R2 disclose creating an oil phase and mixing it with a PVP comprising water-soluble polymer before introducing an aqueous solution. Similarly, neither Hurschmann nor R2 discloses that the oil phase should consist of "melted wax or wax mixture, stearic acid and optionally an emulsifier" as set forth in claim 1.

The subject matter of the claims utilizes a water-soluble polymer selected from PVP, VA/VP copolymer and mixtures thereof, and added to the oil phase, which consists of melted wax, stearic acid and optionally surfactant. This composition is mixed until a stable colloidal complex is formed. Only a very small quantity of PVP emerges from the colloidal complex, even upon subsequent contact with the aqueous phase.

In contrast, Hurschmann describes working all of the components into a suitable water-containing carrier, *see* Hurschmann, paragraph bridging pages 5-6. Thus Hurschmann teaches away from the claims which require (i) formation of an oil phase ***consisting of*** the melted wax or wax mixture, stearic acid and optionally an emulsifier, (ii) formation of a stable colloidal complex by thoroughly mixing the water-soluble polymer with the oil phase, and (iii) emulsifying the colloidal complex in homogeneous form with an aqueous phase. There is simply nothing in Hurschman to suggest mixing the water-soluble polymer with an oil phase ***consisting of*** the melted wax or wax

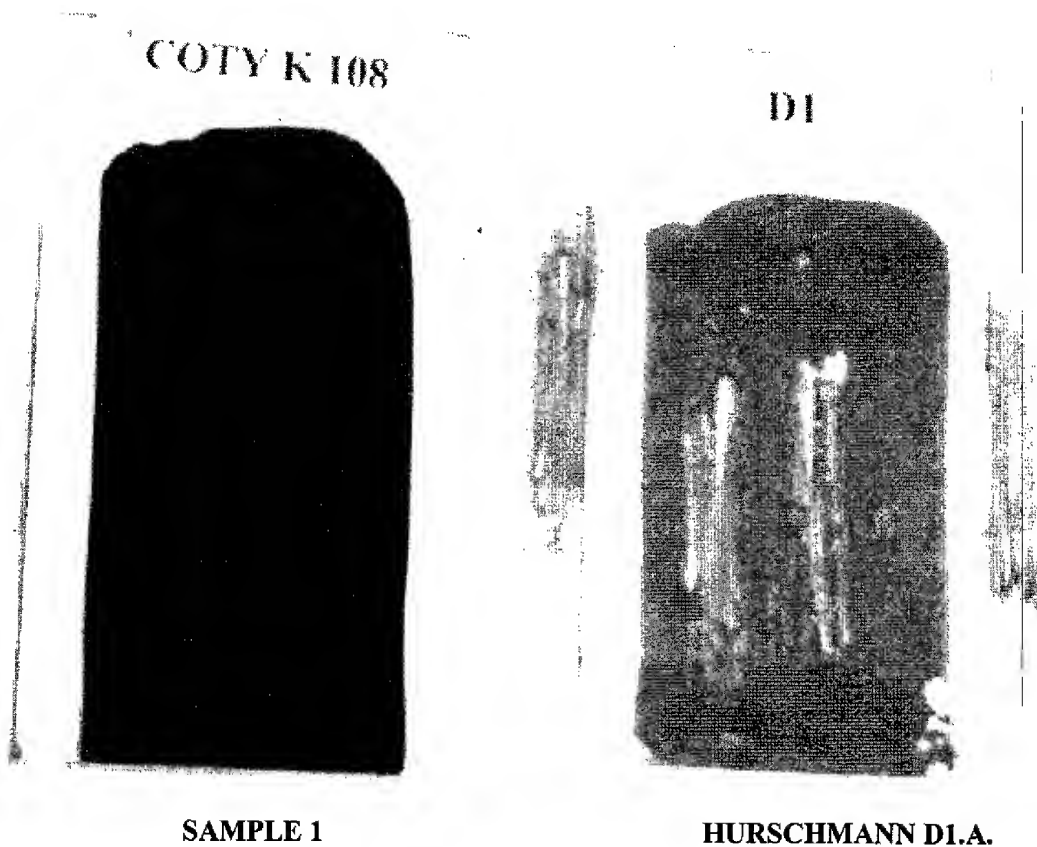
mixture, stearic acid and optionally an emulsifier. Clearly, Hurschmann provides no disclosure or suggestion of the specific manufacturing process that results in a different end product with improved moisture-resistance.

Contrary to the Office Action's assertion that using the same material results in the same product, there is evidence that the claimed product is significantly different from that disclosed or suggested by Hurschmann. First, the specification demonstrates that the product of the claims exhibits twice the moisture-resistance of commercial PVP mascaras, *see* Specification, paragraph [0028]-[0031]. Second, the specification describes that creating the colloidal complex, *i.e.* mixing PVP with the oil phase rather than directly with the aqueous phase, produces significant changes in the PVP crystals that are recovered once the water evaporates, *see* Specification, paragraph [0010]. *This is equivalent to the state of the crystals after the mascara is applied and dries on the hair on which it is applied.* Applicants believe that this difference is a direct result of the process of the claims and that the difference helps explain the improved moisture-resistance.

As additional evidence of the differences between the Hurschmann composition and method and the claimed product-by-process, Applicants submit the accompanying Declaration Under 37 C.F.R. § 1.132 by Ms. Yelena Loginova (hereinafter "Loginova Declaration"). Ms. Loginova prepared samples made using the claimed methodology and composition (Example 1 or Coty K108), Hurschmann methodology and composition (Hurschmann D1.A.), and the claimed methodology with the Hurschmann composition (Hurschmann D1.B), *see* Loginova Declaration, section 2.a). Thus, the differences between Hurschmann D1.A. and the other mascaras, Example 1 and Hurschmann D1.B., are a result of the differences in the process used to make them.

The tape adhesion testing includes images of Example 1 (Coty K108) against Hurschmann D1.A. (the Hurschmann composition and method). Quantitatively, no quantifiable amount of Example 1 mascara was removed, while 0.055 grams of mascara were removed using the Hurschmann D1.A., *i.e.*, Hurschmann formulation R2 using the Hurschmann process, *see* Loginova Declaration, section 2.c). Thus, more than 35% of the Hurschmann D1.A. mascara covered by the tape was removed compared with 0% of the Example 1 mascara, *see* Loginova Declaration, section 2.c). This is not acceptable for a moisture-proof mascara composition and clearly demonstrates that products produced by the claimed process are substantially different, and unexpectedly superior, product when compared to Hurschmann.

In addition, the following images clearly demonstrate the qualitative differences in the amount of mascara removed by the tape test. As is readily apparent, the amount of mascara removed using the tape test is substantially larger with Hurschmann D1.A. than with the Example 1 (as claimed), *see* Figures below & Loginova Declaration, section 2.c).



As explained by Co-inventor Loginova:

The root cause of these different test results described above are believed to be the result of different crystal structures of PVP polymers exposed to the claimed process and those disclosed in Hurschmann and other conventional mascara processing methods. The specification describes that creating the colloidal complex, *i.e.* mixing PVP with the oil phase rather than directly with the aqueous phase, produces significant changes in the PVP crystals that are recovered once the water evaporates, *see* Specification, paragraph [0010]. Applicants believe that this difference a direct result of the

process of the claims and that the difference helps explain the improved moisture-resistance.

In order to confirm this, a study was conducted evaluating PVP crystals resulting from a 4% mixture of PVP in wax and a separate mixture of 4% PVP in water. First, after evaporation of the water, the PVP crystals were 5 wt-% of the PVP/wax mixture, while the PVP crystals were only 4 wt-% of the PVP/water mixture. This demonstrates that the wax has some impact on the PVP crystal structure, *see* Specification, paragraph [0010]. As discussed in the specification, the resulting crystals are also different. The PVP/wax crystals are "large shiny, slightly yellow, harder crystals," while the PVP/water crystals were "very small." Pictures of representative crystals are shown as Sample A (PVP/wax) and Sample B (PVP/water) below.



In order to form the mascara described in Hurschmann, all of the mascara ingredients are simultaneously or sequentially "worked into a suitable **water-containing** carrier." In contrast, the mascara composition set forth in the claims, requires (i) formation of an oil phase consisting of a melted wax or wax mixture, stearic acid and optionally an emulsifier, (ii) formation of a stable colloidal complex by thoroughly mixing the water-soluble polymer with the oil phase, and (iii) finally, emulsifying the colloidal complex in homogeneous form with an aqueous phase. As described in the application, this results in a mascara complex with twice the moisture-resistance found in conventional PVP-containing mascara, such as that which could be produced using Hurschmann. The specification, and the accompanying pictures, outline physical differences in the PVP crystals that result from the claimed PVP/wax mixtures versus the PVP/water mixtures disclosed in Hurschmann. These differences help demonstrate that the product produced by the process set forth in the claims is different from that which is disclosed or suggested by Hurschmann.

The combination of all of this data provides convincing evidence that the claimed method produces a different mascara with different properties than the mascara of the closest prior art, Hurschmann.

Loginova Declaration, section 3.

The Loginova Declaration provides ample evidence that the claimed product-by-process produces a moisture-proof mascara composition that is substantially different from those made using prior art methods, including Hurschmann. As explained by co-inventor Loginova:

the above test results clearly demonstrate that neither Hurschmann nor any other cited reference, whether alone or in combination, disclose or suggest the claimed moisture-proof mascara. Furthermore, the differences in process and end product between Hurschmann and the claims of the Application are neither disclosed nor suggested by Hurschmann or any other cited reference, whether alone or in combination.

Loginova Declaration, section 4.

In summary, Hurschmann teaches away from the claims which require (i) formation of an oil phase *consisting of* the melted wax or wax mixture, stearic acid and optionally an emulsifier, (ii) formation of a stable colloidal complex by thoroughly mixing the water-soluble polymer with the oil phase, and (iii) emulsifying the colloidal complex in homogeneous form with an aqueous phase. There is simply nothing in Hurschman to suggest mixing the water-soluble polymer with an oil phase *consisting of* the melted wax or wax mixture, stearic acid and optionally an emulsifier. Furthermore, Applicants have clearly demonstrated that the claimed moisture-proof mascara composition produced by the claimed method exhibits unexpectedly different and improved properties over "mascara" compositions made using the cited references. Accordingly, Applicants respectfully request that the instant rejections be withdrawn.

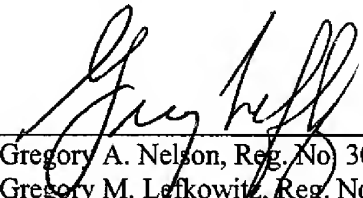
Conclusion

For at least the reasons set forth above, the independent claims are believed to be allowable. In addition, the dependent claims are believed to be allowable due to their dependence on an allowable base claim and for further features recited therein. The application is believed to be in condition for immediate allowance. If any issues remain outstanding,

Applicant invites the Examiner to call the undersigned Greg Lefkowitz at 561-671-3624 (direct line) if it is believed that a telephone interview would expedite the prosecution of the application to an allowance.

Respectfully submitted,

Date: August 8, 2008



Gregory A. Nelson, Reg. No. 30,577
Gregory M. Lefkowitz, Reg. No. 56,216
AKERMAN SENTERFITT
222 Lakeview Avenue; Suite 400
P.O. Box 3188
West Palm Beach, FL 33402-3188
(561) 653-5000

Docket No. 3975-038